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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/015,355 | 12/12/2001 | Michael D. Hooven | HOOV 113 | 1021 |

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| EXAMINER |
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ROLLINS, ROSILAND STACIE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3739

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,355

Applicant(s)

HOOVEN, MICHAEL D. *ED*

Examiner

Rosiland S Rollins

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/12. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 9, 14, 15 and 20 are under 35 U.S.C. 103(a) as being unpatentable rejected by Schmaltz et al. (US 6050996) further in view of Nezhat (US 6162220).

Schmaltz et al. discloses a device for clamping and ablating tissue comprising a first and second handle member, first and second jaw members, first and second elongated conductive ablation members (11, 12), elongate support members (22, 23) supporting substantially the entire length of its associated conductive member and an insulator (24) disposed between the conductive member and the support member. Schmaltz et al. teach all of the limitations of the claims except the tissue-contacting portion having a width that is substantially narrower than the width of the clamping surface. Nezhat discloses a similar device and teach that is old and well known in the art to provide a tissue-contacting portion having a width that is substantially narrower than the width of the clamping surface (figure 2e), to improve the current flow between the tissue-contacting portions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tissue-contacting portion having a width that is substantially narrower than the width of the clamping surface on the Schmaltz et al. device to improve the current flow between.

Claims 2, 4, 8, 10, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al and Nezhat combined. Schmaltz et al. teaches all of the limitations of the claims except the specific dimensions of the ablation member as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the claimed dimensions for the ablation member since it has been held to be within the skill level of a worker in the art to choose the dimensions of an instrument on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 5, 7, 11, 13, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. combined with Nezhat further in view of Yamauchi (US 6273887). Schmaltz et al. teaches all of the limitations of the claims except the conductive member being a wire. Yamauchi disclose a similar device and teach that it is old and well known in the art to provide a wire electrode to decrease the contact area between the electrode and tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a wire as the conductive member of Schmaltz et al. to limit the contact area between the electrode and tissue and focus the energy being supplied to the tissue.

Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. combined with Nezhat further in view of Baker (US 6113598). Schmaltz et al. teach all of the limitations of the claims except the conductive ablation members defining an interior bore. Baker it all teach that it is old and well known in the art to provide conductive ablation members with an interior bore (figures 11-14) to assist in

the reduction of charring. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an interior bore in the conductive ablation members of Schmaltz et al. particularly in view of the teaching of Baker.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
Art Unit 3739

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